

Boyd

dilating said incision further by inserting the [distal] leading end of the first tube thereinto, said insertion being accomplished by sliding said first tube toward the incision over said second tube until the leading end of the first tube is flush with the leading end of the second tube, said second tube serving to guide the first tube to the incision; and

withdrawing said second tube from the inner bore of said first tube and leaving said first tube in the incision so that subsequent [arthroscopic] surgical instruments may be introduced to a surgical site through the inner bore of said first tube.

REMARKS

The nonfinal Examiner's Action mailed 04/18/95, having a shortened statutory period for response set to expire 07/18/95, and all references cited therein, have been carefully studied by Applicants. The amendments appearing above and these remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

Claim 2 has been amended so that it can no longer be construed as simultaneously describing the respective contributions of Applicants and Smith '891. The claim now recites that the steps of the novel method include placing the respective leading ends of the dilator tubes flush with one another, in the manner depicted in Applicants' Fig. 22. As indicated in Fig. 1 of Smith, the respective leading ends of the tubes are not flush with one another when the steps of the Smith method are followed. Significantly, this is not a mere happenstance distinction between the methods of

Applicants and Smith; Smith's structure requires the staggering of leading ends as depicted in Fig. 1. Specifically, the trailing end of each tube is turned inwardly as depicted in Fig. 10 and as described in col. 4, lines 25-27. The reason for such "radially inwardly projecting flanges" is "to provide limitation as to forward movement of the mounted dilators with respect to the first dilator element." Col. 4, lines 34-37. Thus, Smith expressly teaches away from Applicants' method as now claimed.

Note in Applicants' Fig. 22 that Applicants' method enables the leading end of each successively larger in diameter tube to abut the surgical site. Smith's method allows no such abutment. Thus, the surgical procedure depicted in Applicants' Fig. 25 could not be performed with the Smith device and method. Applicants' method represents a clear advance over the Smith method, and Applicants are entitled to the *quid pro quo* constitutionally guaranteed to those who advance the useful arts in new and nonobvious ways.

Claim 3 has been cancelled. That claim was directed to the base member depicted in Fig. 2, and said structure is protected in claim 6 in combination with the dilator tube of Fig. 3. Since the primary utility of the Fig. 2 base member is its use with said Fig. 3 dilator tube, the structural differences between said base member and cystoscope 10 of Baumgartner need not be further pointed out by Applicant. For the record, Applicant points out that the Office has misconstrued Applicant's position; Applicant accurately pointed out that shaft 22 is solid and that it therefore has no interior bore in fluid communication with the bore of

sheath 12. The Office replied that base 16 of sheath 12 has a recess "which is in fact in communication with the bore of tube 12." Applicant never argued the position that the Office refutes, but the point is moot in view of the cancellation of claim 3 for the reason given.

For these reasons, and in fairness to Applicants, the contention that Smith would have suggested the claimed invention to one of ordinary skill in the art at the time the claimed invention was made should be withdrawn in view of the amendments made to claim 2.

Applicant solicits a Notice of Allowance indicating the allowance of claims 2, 5, and 6.

CONCLUSION

Even though the initial claims were drawn to a new, useful, and nonobvious invention, they have now been amended to describe the invention with increased specificity.

Thus, no estoppel has been created by these amendments. See Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc., 230 U.S.P.Q. 45 (Fed. Cir. 1986). (In cases where a patentee's amendments were not required in response to an examiner's rejection, or critical to the allowance of the claims, no estoppel has been found,") citing Great Northern Corp. v. Davis Core & Pad Co., 782 F.2d 159, 228 U.S.P.Q. 356 (Fed. Cir. 1986) and Datascope Corp. v. SMEC, Inc., 776 F.2d 320, 227 U.S.P.Q. 838 (Fed. Cir. 1985). Also, see Insta-Foam Products Inc. v. Universal Foam Systems, Inc. 15 U.S.P.Q. 2d 1295 (Fed. Cir. 1990).

If the Office is not fully persuaded as to the merits of Applicants' position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a

telephone call to the undersigned at (813) 538-3800 is requested.

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Very respectfully,

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